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*Edwin J. Branton* (Name)

*8/17/02* (Date)

CB

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of: )

Applicant: Alexandria Real Estate )  
Equities, Inc. )

Serial No.:                      75982917 )

Trademark Law Office: 103

Filed: December 29, 2000 )

Trademark Attorney: Joanna M. Dukovcic

Mark: LABSPACE )

Assistant Commissioner for Trademarks  
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Arlington, Virginia 22202-3513  
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**RESPONSE TO OFFICE ACTION AND  
REQUEST FOR RECONSIDERATION**

In the above-captioned application, Applicant Alexandria Real Estate Equities, Inc. (“Applicant”), by and through its counsel, hereby responds to Office Action No. 2, dated February 8, 2002 regarding the LABSPACE mark ( the “Mark”), as follows:



I. AMENDMENT TO THE APPLICATION

Applicant's Mark LABSPACE is capable of distinguishing its services because it has the potential to indicate the source or origin of its services. Although Applicant believes its Mark is entitled to registration on the Principal Register for all the services in the application, in response to the Office Action, it requests that its Application be amended to seek registration for the following services *only* on the Supplemental Register pursuant to the Lanham Act, 15.U.S.C. § 1091:

Operation of businesses for others, namely life science research; business management in International Class 35;

Real estate services, namely real estate brokerage, leasing and management services; land acquisition, namely real estate brokerage services; rental of real estate, namely rental of commercial, manufacturing, and research and development space; leasing of real property in International Class 36;

Real estate development services; building construction and repair services; maintenance and/or repair of buildings, electrical systems, heating and air conditioning systems, and plumbing systems in International Class 37;

Rental of warehouse space in International Class 39; and

Architectural design services; engineering services in International Class 42

Pursuant to this amendment, for the above-referenced services *only*, all references in the application to the "Principal Register" should be amended to read "Supplemental Register," including the following reference in the application as originally filed: page 1, second paragraph, second and third lines.

Applicant continues to seek registration on the Principal Register for the remaining services in the application, which are:



Business consulting services; business incubator services, namely business management and business development services in the form of start-up support for businesses of others; rental and leasing of office machinery and equipment in International Class 35;

*Allegedly  
in the*  
Investment brokerage, consultation, and management; financial portfolio management; financial services, namely financial consultation, financial analysis, financial planning, financial management, financial portfolio management, financing services, and providing debt and equity capital; incubator financing services in International Class 36; and

Rental and leasing of computers in International Class 42

Applicant encloses a Request to Divide the application, requesting that the services sought to be registered on the Principal Register be retained in this parent application (Serial No. 76/187,873) and that the services sought to be registered on the Supplemental Register comprise the subject of a new application.

**A. Applicant has Amended its Recitation of Services in Response to the Examining Attorney's Request**

Applicant has amended the recitation of services in response to the Examining Attorney's request. Applicant believes that as amended, its recitation of services complies with all Patent and Trademark Office requirements.

**II. BASIS FOR RECONSIDERATION: APPLICANT'S MARK IS NOT MERELY DESCRIPTIVE OF APPLICANT'S SERVICES**

**A. Introduction**

The Examining Attorney has refused registration of Applicant's Mark on the basis that the Mark merely describes Applicant's services. Applicant has amended its application to seek registration for some of its services on the Supplemental Register. Accordingly, Applicant submits that the refusal on the grounds that the Mark is merely descriptive of *these* services is now moot.



Regarding the remaining services for registration on the Principal Register, as set out above, Applicant respectfully disagrees with the Examining Attorney's assertion that the Mark is descriptive of these services. Applicant maintains that its Mark, as a whole, is at most suggestive of these services and the following arguments pertain to *these* services.

The Patent and Trademark Office has the burden of demonstrating that the Applicant's Mark is merely descriptive. See In re Bel Paese Sales Co., 1 U.S.P.Q.2d 1233, 1236 (T.T.A.B. 1986). In addition, "any doubt with respect to the issue of descriptiveness should be resolved in applicant's behalf." In re Grand Metropolitan Foodservice, Inc., 30 U.S.P.Q.2d 1974, 1976 (T.T.A.B. 1994). When examined in light of the services and the legal standards, Applicant's Mark is clearly suggestive, not descriptive, and therefore entitled to registration on the Principal Register.

**B. Applicant's Mark is Not Descriptive and Meets the Imagination Test**

The Examining Attorney has refused registration of Applicant's Mark on the ground Applicant's Mark, when used with its services, is merely descriptive. The Examining Attorney's refusal is respectfully traversed.

Standards for the registrability of marks are set forth in AMF Incorporated v. Sleekcraft Boats, 204 U.S.P.Q. 808, 815 (9th Cir. 1979). In reviewing the distinction between descriptive and suggestive marks, the Court stated:

The primary criterion is "the imaginativeness involved in the suggestion" . . . that it is, how *immediate* and direct is the thought process from the mark to the particular product . . . (Emphasis added)

A mark is merely descriptive if "when applied to the relevant goods, it immediately imparts information concerning those goods to an average prospective purchaser of the goods." In re Intelligent Medical Systems, Inc., 5 U.S.P.Q. 1674, 1675 (T.T.A.B. 1987). The



immediate idea must be conveyed with a "degree of particularity." In re TMS Corporation of the Americas, 200 U.S.P.Q. 57, 59 (T.T.A.B. 1978).

Applying these principles to the Applicant's Mark, a consumer would have to use his or her imagination to make the leap from the allegedly commonly understood meaning of the words LAB SPACE to know what services are actually offered under the LABSPACE mark. It is not immediately clear that the mark LABSPACE refers to services, namely, providing business consulting, incubator, and financial services.

The Examining Attorney has taken the position that Applicant's Mark is descriptive because "[w]hen the mark is applied to the applicant's services, the user is directly informed that all the applicant's services are provided for the purpose of acquiring and maintaining lab space." Office Action No. 2, page 2-3. The Examining Attorney also enclosed and referred to Nexis and Internet articles that refer to "lab space" and "laboratory space" and stated that these words are used interchangeably. However, these references are for physical locations and buildings and do not automatically indicate Applicant's services, as suggested by the Examining Attorney.

Nothing about Applicant's Mark indicates that the services provided under it are business consulting, incubation, and financial services. Manifestly, the Mark does not describe these services with any degree of particularity. In fact, the Examining Attorney's analysis of the allegedly descriptive mark reveals the type of sequential logic associated with suggestive marks, not descriptive marks. Descriptive marks *immediately* convey information about the nature of the goods or services; they do not require a consumer to engage in speculation or sequential reasoning about what the nature of the services may or may not be.



That a purchaser may, through imagination, eventually connect LABSPACE to Applicant's financial, business consulting and incubation services indicates only that Applicant's Mark may be suggestive. In short, Applicant's Mark "requires imagination, thought and perception to reach a conclusion as to the nature" of the goods or services. Stix Products, Inc. v. United Merchants & Mfrs., Inc., 295 F. Supp. 479, 488 (S.D.N.Y. 1968); see also 2 McCarthy, Trademarks and Unfair Competition, §11.67, at 11-116 (4th ed. 1997). Thus, Applicant's Mark cannot be merely descriptive.

In In re TMS Corporation of The Americas, 200 U.S.P.Q. 57 (T.T.A.B. 1978), the mark THE MONEY SERVICE was found registrable. In determining that THE MONEY SERVICE was suggestive of financial services rather than descriptive, the Trademark Trial and Appeal Board stated:

To effect a readily understood connection between applicant's mark and its services requires the actual or prospective customer to use thought, imagination and perhaps an exercise in extrapolation. Id. at 59.

To connect LABSPACE with Applicant's services similarly requires an average purchaser to use thought, imagination and extrapolation. There is no immediate connection conveyed between the Mark and Applicant's services.

The line between merely descriptive and suggestive terms is not clear and is very often narrow. See, e.g., In re Atavio Inc., 25 U.S.P.Q. 2d 1361 (T.T.A.B. 1992). A descriptive mark must immediately convey information regarding the goods or services. See In re Intelligent Medical Systems, Inc., supra. Applicant's Mark does not immediately convey that information.

If the mental leap between the word and product's attributes is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness. See 2 McCarthy, supra, §11.67, at 11-128. The consumer's mind would not jump immediately from the name



LABSPACE to knowledge of Applicant's financial and business incubation services. At best and only with imagination, reflection, and mental pause would a consumer be able to glean something about a quality or characteristic of Applicant's services. Because of the mental steps required to associate the Mark with Applicant's services, it cannot be "merely descriptive." Rather, the Mark is suggestive and functions as an indicator of source of Applicant's services.

**C. The Lack of Evidence Militates in Favor of Non-Descriptiveness**

The PTO has the burden of proving that a mark "is perceived by the public as a common descriptive or generic designation." In re Bel Paese Sales Co., supra, at 1234. This burden has not been met.

In In re Men's International Professional Tennis Council, 1 U.S.P.Q. 2d 1917, 1918 (T.T.A.B 1986), the Board decided in favor of applicant, reversing a descriptiveness rejection of MASTERS as a service mark for organizing and conducting an annual tennis tournament. The Examining Attorney had cited a dictionary definition of "master" as "a person who is highly skilled, ingenious, or dexterous in some area of activity." Id. at 1918. The Board held:

Conspicuously absent from this definition are any references to tennis or any other competitive sport as examples of this or any other of the meanings of this word. Such generally relevant meanings are not a proper basis for applying a more strict standard to the question of registrability than that ordinarily applied and are frequently insufficient even to satisfy the ordinary standard of descriptiveness which justifies a Section 2(e)(1) refusal . . . [T]he above cited general dictionary meaning of 'master' is immaterial to the only issue which we have to decide and the absence of any particular reference to tennis in the dictionary probably favors appellant's position that the mark should be published rather than that it should be refused ex parte. (Emphasis added) Id.

In a like manner, the evidence relied upon by the Examining Attorney makes no applicable reference to Applicant's services. The Examining Attorney's evidence consisted of Nexis and Internet articles that refer to "lab space" and "laboratory space." However, these references are for physical locations and buildings. The Examining Attorney attributed to the articles she enclosed more information than they contained and she engaged in a cognitive reasoning process to conclude that the Mark is descriptive. The references provided fall substantially short of satisfying the burden of demonstrating that LABSPACE is descriptive for business consulting and financial services, and the reasoning process and sequential analysis relied upon by the Examining Attorney is a hallmark of a suggestive mark.

In In re Synergistics Research Corp., 218 U.S.P.Q. 165 (T.T.A.B. 1983), the Board reversed the refusal of registration of the mark BALL DARTS for equipment consisting of spherical missiles and targets sold as a unit for playing a target game (i.e., a "dart" game using ball darts instead of pointed darts). The Board held that BALL DARTS was not generic or highly descriptive of the goods, despite applicant having used the term "dart game" and "dart-balls" on the packages for the goods, and despite the absence of any generic word for the goods on the applicant's packages.

The Board in Synergistics Research relied in part on the fact the Examining Attorney had not introduced any evidence of the use of either of the terms "ball darts" or "dart balls" by competitors or by the public. Id. at 167. Similarly, not one use of the term LABSPACE by competitors or the public has been made of record by the Examining Attorney for business consulting, incubator or financial services. To refuse registration on the ground that a mark is descriptive, the Examining Attorney must make a substantial showing based on clear

evidence of descriptive use. In re Kopy Kat, Inc., 183 U.S.P.Q. 372 (C.C.P.A. 1974). No such substantial showing has been here made.

LABSPACE falls short of immediately imparting information concerning Applicant's services in any one degree of particularity. It requires significant "thought and imagination" to relate LABSPACE to Applicant's business consulting and financial services. Applicant's Mark is not merely descriptive. Any doubt in this regard must be resolved in favor of Applicant. See In re Intelligent Medical Systems, *supra*, at 1676; In re The Rank Organization, 222 U.S.P.Q. 324, at 326 (T.T.A.B. 1984).

**D. Applicant's Mark Meets Other Tests for Suggestiveness**

The absence of a need by Applicant's competitors to use LABSPACE in their marks to describe their services is additionally probative of the non-descriptiveness of Applicant's Mark.

In Aluminum Fabricating Co. of Pittsburgh v. Season-All Window Corp., 119 U.S.P.Q. 61, 63 (2d Cir. 1958), the Court determined that SEASON-ALL was not a term needed by competitors to sell storm doors and windows for which that mark was used by the plaintiff. It therefore held the mark to be non-descriptive.

Similarly, in Reynolds Metals Co., 178 U.S.P.Q. 296 d (C.C.P.A. 1973), the mark BROWN-IN-BAG for cooking bags usable in browning meats was held to be non-descriptive because its registration for transparent plastic bags would not prevent competitors from describing similar products. The Court also stated, "one may be informed by suggestion as well as by description." *Id.* at 297.

Like the marks SEASON-ALL and BROWN-IN-BAG, the mark LABSPACE is not needed by competitors to adequately describe business consulting and financial services. Applicant's use of LABSPACE does not deprive competitors of an "apt description of their

[services].” See No Nonsense Fashions, Inc. v. Consol. Foods Corp., 226 U.S.P.Q. 502, 507 (T.T.A.B. 1985).

The courts also look to determine the extent to which other sellers have used the mark on similar merchandise or with similar services. In determining whether a word “has a descriptive or suggestive significance as applied to merchandise, it is proper to take notice of the extent to which it has been used in trademarks by others on such merchandise.” Shoe Corp. of America v. Juvenile Shoe Corp., 266 F.2d 793, 796 (C.C.P.A. 1959).

As the Examining Attorney has cited no third party uses of LABSPACE for similar services, the answer here must be that competitors do not need to use the Mark.

### III. CONCLUSION

It is noted that a search of the Patent and Trademark Office records fails to show that Applicant’s Mark so resembles any registered mark or pending application as to be likely to cause confusion, mistake or deception. In view of the foregoing, Applicant submits that this application is now in condition for acceptance. Favorable action is therefore requested.

Respectfully submitted,

COOLEY GODWARD LLP

Date: August 7, 2002

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**Re: Response to Office Action and Request for Reconsideration, and Request to Divide Application**  
**Applicant:** Alexandria Real Estate Equities, Inc.  
**Serial No.:** 75982917  
**Our File:** Alexandria Real Estate Equities, Inc./LABSPACE/US Classes, 35, 36, 37, 39, and 42

Dear Sir or Madam:

Enclosed for filing in connection with the above referenced trademark application for the mark LABSPACE; please find the following:

1. Response to Office Action and Request for Reconsideration;
2. Request to Divide Application;
3. Two checks: one for \$975.00; and another for \$100.00; and
4. A self-addressed stamped return postcard.

Please charge any deficiency or credit any overpayment of the enclosed fee to Deposit Account No. 03-3118. A duplicate copy of this letter as authorization is attached hereto for your convenience.

Please return the enclosed stamped, self-addressed postcard evidencing the date of receipt of the Response. Thank you.

Very truly yours,

COOLEY GODWARD LLP

Mary C. O'Connor

Enclosures

cc: Joel S. Marcus, Esq.  
Ms. Jennifer Buchalter  
Janet L. Cullum, Esq.

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